

## **REMARKS**

### **I. Introduction**

This paper is responsive to the final Office Action mailed October 20, 2010. The Applicant and undersigned thank Examiner Hoang for his careful consideration of the present application.

The final Office Action sustained the rejections of the pending claims, noting on page 3 that the claim language does not require “that the first portion of a database contains the first sub-portion only and the second portion of the database contains the second sub-portion only.”

Although the Applicant respectfully disagrees that the previously pending claims are unpatentable over the cited references, independent claims 3, 15, and 18 are amended in accordance with the suggestion in the final Office Action to specify that the database comprises “a first portion subdivided into first sub-portions and a second portion subdivided into second sub-portions.” Independent claims 3, 15, and 18 are also amended to include the subject matter in previously pending claim 7. Claim 7 is canceled. Dependent claims 5, 8, 9, and 20 are amended to resolve antecedent basis and dependency issues created from the amendments to claims 3, 15, and 18.

The Applicant requests that these amendments be entered at least because the amendments adopt examiner suggestions and place the application in condition for allowance. See MPEP §§ 714.12 (“Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered.”), 714.13(II) (“An amendment filed at any time after final

rejection, but before an appeal brief is filed, may be entered ... provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.”)

Claims 3, 5-6 8-15, 18, and 20 are pending after entry of the claim amendments.

The Applicant submits that the amended claims are patentable, as explained below. Accordingly, the Applicant respectfully requests that the U.S. Patent & Trademark Office (the “Office”) issue a Notice of Allowance without delay.

## **II. Claims 3, 5, 15, 18, and 20 are Patentable**

The Office Action rejected claims 3, 5, (previously pending claim 7), 15, 18, and 20 as obvious over U.S. Patent No. 6,539,387 to Oren, *et al.* in view of U.S. Pub. No. 2002/0059459 to Koka. The Applicant respectfully traverses these rejections for the following reasons.

### **A. The Claims Include Features Absent from the Cited References**

#### **i. First and second portions and sub-portions**

The Applicant submits that Oren and Koka fail to disclose or suggest a database that comprises “a first portion subdivided into first sub-portions and a second portion subdivided into second sub-portions” and that a user-executable navigation link is established “from at least one sub-portion of the first sub-portions to a second sub-portion of the second sub-portions,” as in claims 3, 15, and 18.

According to the final Office Action, Koka discloses “navigating from a first sub-portion of a web page to another non-sequential sub-portion of the same web page using means of hyperlinks [citations omitted].” Final Office Action, p. 3. Even assuming the Office correctly interpreted Koka, the Applicant submits that such teachings fail to disclose or suggest the above-identified features that are in each of independent claims 3, 15, and 18. Likewise, Oren fails to disclose or suggest these features. Instead, Oren discloses links between pages that are have a direct relationship (described as a parent and child) in consecutive levels in the hierarchy. See Oren, col. 7, lines 5-17; Fig. 2.

Withdrawal of the rejection and allowance of claims 3, 5, 15, 18, and 20 for at least this reason is kindly requested.

ii. Primary key expressions

The references also fail to disclose or suggest features in previously pending claim 7: “defining primary key expressions, by a compiler, in the information that is stored in selected sub-portions of at least one of the first sub-portions or the second sub-portions” and “responsive to receiving a user selection of at least one of the primary key expressions, using the at least one of the primary key expressions to establish a user-executable navigation link from at least one sub-portion of the first sub-portions to a second sub-portion of the second sub-portions,” as in claims 3 and 18. Claim 15 includes similar requirements.

The final Office Action contended that Oren discloses these features, explaining that Oren at column 8, lines 55-65 teaches “[t]he use of these chapter

and paragraph types provides the capability to perform a keyword search for a word or term limited to a specific type of chapter or paragraph, or to limit a search through an index to a specific type of chapter or paragraph.” Final Office Action, p. 7. Even assuming for the sake of argument that these chapter or paragraph types in Oren are “primary key expressions,” Oren does not disclose establishing a user-executable navigation link from a sub-portion of first sub-portions to another sub-portion of second sub-portions using the chapter or paragraph types. Instead, Oren discloses that chapter or paragraph types can be used to limit the scope of paragraphs or chapters to be searched using a keyword; not that different portions of different sub-portions can be linked.

Accordingly, Oren fails to disclose or suggest these features. Likewise, Koka fails to disclose or suggest these features and the Office did not rely on Koka as disclosing or suggesting these features.

Withdrawal of the rejection and allowance of claims 3, 5, 15, 18, and 20 for at least this additional reason is requested.

**B. The “Reasons to Combine” Oren and Koka are Inadequate to Support a Rejection**

The Applicant submits that no reason existed for one of ordinary skill in the art to modify Oren to include teachings from Koka. The Applicant has previously identified its position that various findings in support of the Section 103 rejections are in error and that, in view of the errors, the Section 103 rejections should be withdrawn. In addition, the Applicants respectfully assert that the

rejection should be withdrawn because no sufficient explanation has been provided to date in support of the legal conclusion of obviousness.

*KSR, Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) states that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)) (emphasis added).

In the final Office Action, the Office contended that "[s]ince both Oren and Koka disclose storing and retrieving relative position of related pages within a document, they are appropriate to be combined with one another" and that "[i]t would have been obvious to a[] ordinary person of skill[] ] in the art to incorporate the teachings of Koka with the teachings of Oren for the purpose noted above." Final Office Action, pp. 2-3.

The MPEP, however, is clear that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." MPEP § 2143.01(III) citing *KSR, Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385, 1396 (2007) (emphasis added).

The MPEP is also clear that "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without

some objective reason to combine the teachings of the references. MPEP § 2143.01(IV) citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Here, the Office has alleged that because Oren and Koka teach (according to the Office's interpretation to which the Applicant does not subscribe) storing and retrieving relative positions of related pages within a document, one of ordinary skill would have had a reason to combine any teachings of these references together. Such reasoning merely alleges that Oren and Koka (according to the Office's interpretation; not the Applicant's) relate to similar subject matter such that Oren and Koka can be combined. Moreover, the Office offers no objective reason, supported by evidence of record, to combine the teachings of the references. The Applicant respectfully submits that such reasoning is improper under MPEP §§ 2143.01(III), 2143.01(IV).

Moreover, the Applicant submits that whether Oren and Koka "are appropriate to be combined with one another" uses impermissible hindsight reasoning. Obviousness is determined as a matter of foresight, not hindsight. See *KSR, Int'l Co. v. Teleflex, Inc.*, 550 U.S. at 421 citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966). Accordingly, the Office failed to articulate a reason, supported by evidence of record, why one of skill in the art **would have combined** Oren with certain teachings from Koka.

In any event, the issue is not whether one would have generally combined Oren and Koka. The issue for claims 3, 15, and 18 is whether one of skill in the art, at the time the present invention was made and having Oren and Koka

before him or her, would have modified Oren to include the following teachings (according to the Office's interpretation) from Koka: (i) "while the linking of the URL addresses set forth above is sequential, that is from 40 to 40' to 40" along the length of the page 30, additional links can be provided to jump to different portions in a non-sequential order;" and (ii) "arid links may be provided to return to previous pages." See, e.g., Final Office Action, p. 6.

The Office has not established that any reason existed at time of invention for one of ordinary skill to modify Oren to include these alleged teachings from Koka; nor has the Office put forward evidence to establish that modifying Oren in the manner proposed by the Office would have been predictable.

Indeed, no reason existed. Oren expressly teaches away from including "additional links [that] can be provided to jump to different portions in a non-sequential order" (teachings, according to the Office, from Koka). Oren's purpose is to solve the problem of having links to jump to differential portions in a non-sequential order. See Oren, Fig. 1; col. 1, lines 41-64. The MPEP states that "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V) citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). That is the case here.

Withdrawal of the rejection and allowance of claims 5, 15, 18, and 20 for at least this additional reason is requested.

**III. Claims 6 and 14 are Patentable**

The Office Action rejected claims 6 and 14 as obvious over Oren in view of Koka and U.S. Pub. No. 2001/0047358 to Flinn, *et al.* Each of claims 6 and 14 depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 6 and 14 are also patentable. Withdrawal of the rejection and allowance of claims 6 and 14 is kindly requested.

Moreover, the Applicant respectfully submits that the Office failed to establish a reason why one would have combined the identified teachings (according to the Office) of Oren, Koka, and Flinn. Withdrawal of the rejection and allowance of claims 6 and 14 for this additional reason is kindly requested.

**IV. Claims 8-10 are Patentable**

The Office Action rejected 8-10 as obvious over Oren in view of Koka and U.S. Patent No. 6,714,215 to Flora. Each of claims 8-10 ultimately depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 8-10 are also patentable. Withdrawal of the rejection and allowance of claims 8-10 is kindly requested.

Moreover, the Applicant respectfully submits that the Office failed to establish a reason why one would have combined the identified teachings (according to the Office) of Oren, Koka, and Flora. Withdrawal of the rejection and allowance of claims 8-10 for this additional reason is kindly requested.



**V. Claim 11 are Patentable**

The Office Action rejected claim 11 as obvious over Oren in view of Koka, Flora, and Flinn. Claim 11 ultimately depends from and further limits claim 3. Reasons for allowance claim 3 are provided above. For at least those same reasons, the Applicant submits that claim 11 is also patentable. Withdrawal of the rejection and allowance of claim 11 is kindly requested.

Moreover, the Applicant respectfully submits that the Office failed to establish a reason why one would have combined the identified teachings (according to the Office) of Oren, Koka, Flinn, and Flora. Withdrawal of the rejection and allowance of claim 11 for this additional reason is kindly requested.

**VI. Claims 12 and 13 are Patentable**

The Office Action rejected claims 12 and 13 as obvious over Oren in view of Koka, Flora and U.S. Patent No. 5,761,436 to Nielsen. Each of claims 12-13 ultimately depend from and further limit claim 3. Reasons for allowing claim 3 are provided above. For at least those same reasons, the Applicant submits that claims 12-13 are also patentable. Withdrawal of the rejection and allowance of claims 12-13 is kindly requested.

Moreover, the Applicant respectfully submits that the Office failed to establish a reason why one would have combined the identified teachings (according to the Office) of Oren, Koka, Flora, and Nielsen. Withdrawal of the

rejection and allowance of claims 12-13 for this additional reason is kindly requested.

## **VII. Conclusion**

The above amendments and remarks completely respond to the Office Action and place the application in condition for allowance, which is respectfully requested. No fee is believed to be due for this submission. If any additional fees are due for this submission, the fees may be charged to Deposit Account number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404-745-2520.

Respectfully submitted,

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